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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/736,195	12/15/2003	Paul Adriaan Van Der Schaaf	LS/91-22115/CONT	4349
324	7590 09/24/2004		EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION			BARTS, SAMUEL A	
PATENT DE 540 WHITE	PARTMENT PLAINS RD		ART UNIT	PAPER NUMBER
P O BOX 200			1621	
TARRYTOW	VN, NY 10591-9005		DATE MAILED: 09/24/2004	1

Please find below and/or attached an Office communication concerning this application or proceeding.

·		Application No.	Application No. Applicant(s)					
Office Action Summary		10/736,195	VAN DER SCHAA	AF ET AL.				
		Examiner	Art Unit					
		Samuel A Barts	1621					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply								
THE - Exter after - If the - If NC - Failu Any I	ORTENED STATUTORY PERIOD FOR RIMAILING DATE OF THIS COMMUNICATION Insions of time may be available under the provisions of 37 CF SIX (6) MONTHS from the mailing date of this communication is period for reply specified above is less than thirty (30) days, and period for reply is specified above, the maximum statutory pure to reply within the set or extended period for reply will, by steeply received by the Office later than three months after the red patent term adjustment. See 37 CFR 1.704(b).	ON. FR 1.136(a). In no event, however, man. a reply within the statutory minimum of eriod will apply and will expire SIX (6) statute, cause the application to become	ay a reply be timely filed of thirty (30) days will be considered time MONTHS from the mailing date of this one ABANDONED (35 U.S.C. § 133).					
Status								
1)[Responsive to communication(s) filed on							
2a) <u></u> ☐	This action is FINAL . 2b) \boxtimes	NAL. 2b)⊠ This action is non-final.						
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is							
	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims								
4)🖂	4)⊠ Claim(s) <u>1-9</u> is/are pending in the application.							
	4a) Of the above claim(s) is/are withdrawn from consideration.							
5)□	5) Claim(s) is/are allowed.							
6)⊠	Claim(s) <u>1-9</u> is/are rejected.							
•	Claim(s) is/are objected to.							
8)□	Claim(s) are subject to restriction a	nd/or election requirement.						
Applicati	on Papers							
9)[The specification is objected to by the Exar	niner.						
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.								
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).								
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.								
Priority u	ınder 35 U.S.C. § 119							
_	Acknowledgment is made of a claim for fore All b) Some * c) None of: 1. Certified copies of the priority documents		C. § 119(a)-(d) or (f).					
 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 								
3. Copies of the certified copies of the priority documents have been received in this National Stage								
	application from the International Bu	*		3.				
* See the attached detailed Office action for a list of the certified copies not received.								
Attachmen	t(s)							
_	e of References Cited (PTO-892)	4) 🔲 Intervi	ew Summary (PTO-413)					
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date								
	nation Disclosure Statement(s) (PTO-1449 or PTO/SE r No(s)/Mail Date <u>3/18/04</u> .	3/08) 5) 1 Notice 6) 1 Other:		J-152)				

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-25 of copending Application No. 10/111,947(111')¹. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is ether anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428,46 USPQ2d 1226 (fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)

¹ The application has been allowed but has not issued as a patent One the application issues as a patent this rejection will be converted to an obvious-type double patenting rejection.

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Although the conflicting claims are not identical, they are not patentably distinct from each other one of the process claimed in the 111' application is the same process as instantly claimed. The instant claims read it the first three lines of claim 20 in the application. The 111' application simply includes as an alternative other processes. The first portion of claim 20 in the application is not patentably distinct from what is instantly claimed.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A Barts whose telephone number is 571-272-2870. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Samuel A Barts Primary Examiner

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